

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION
OF: GEWEHR ET AL.
SERIAL No. 10/616,950
FILED: JULY 11, 2003
FOR: FUNGICIDAL USE

DOCKET No.: AM200040
CONFIRMATION No.: 2161
GROUP ART UNIT: 1616
EXAMINER: SABIHA N. QAZI

Honorable Commissioner
for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO NOTIFICATION OF
NON-COMPLIANT APPEAL BRIEF

Sir:

For the reasons set forth in the attached remarks it is respectfully asserted that the Notification of Non-Compliant Appeal Brief dated November 14, 2006, was issued in error and should be revoked.

It is respectfully requested that a one month extension of time be granted in this case. The respective \$120.00 fee is paid by credit card (Form PTO-2038 enclosed).

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 14.1437. Please credit any excess fees to such deposit account.

Respectfully submitted,

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R E M A R K S

The Examiner referred in form PTOL-462 to "The Appeal Brief filed on 28 June 2006." Appellants submitted the brief on appeal on August 28, 2006. On June 28, 2006, appellants had filed a Notice of Appeal and a reply to a non-final Office action dated February 28, 2006.

The Examiner asserted in subsection (1) of form PTOL-462 that appellants' brief: "does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading in the proper order." Appellants' brief contained the following items in the recited order under the respective headings:

Heading	Compare Brief, page(s):
Real Party in Interest	1, 2
Related Appeals and Interferences	1, 2
Status of the Claims	1, 2
Status of the Amendments	1, 2
Summary of the Claimed Subject Matter	1, 2 to 4
Ground(s) of Rejection to be Reviewed	1, 4
Argument(s)	1 and 4 to 10
Conclusion	1, 10 and 11
Claims Appendix	1, 12
Evidence Appendix	1, 13
Related Proceedings Appendix	1, 14

The Examiner's indication in subsection (1) of form PTOL-432 is therefore clearly in error.

The Examiner asserted in subsection (2) of form PTOL-462 that appellants' brief: "does not contain a statement of the status of all claims, or does not identify the appealed claims." Appellants' brief contained the following statements under the heading "Status of the Claims:" on page 2:

Claims 1, 2, 4 and 5 are currently pending in the application. A copy of these claims is found in the attached Appendix. The current status of those claims is as follows:

- *Claims 1, 2, 4 and 5 stand rejected;*
- *Claim 3 was canceled in a preliminary amendment submitted upon filing of the application;*

- *No Claim(s) stand(s) allowed;*
- *No Claim(s) stand(s) objected to; and*
- *No Claim(s) stand(s) withdrawn from consideration.*

A copy of the claims currently pending in the application is provided in Appendix I of this paper.

Additionally, appellants stated on page 1 of the brief:

This is an appeal from the Examiner rejection of Claims 1, 2, 4 and 5, dated February 28, 2006. Claims 1, 2, 4 and 5 are currently pending.

The Examiner's indication in subsection (2) of form PTOL-432 is therefore clearly in error.

The Examiner asserted in subsection (3) of form PTOL-462 that: "At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment." The Examiner issued a final rejection on August 19, 2005. Appellants requested continued examination under Rule 114 on January 19, 2006. The Examiner then, on February 28, 2006, issued a non-final Office action "responsive to communication(s) filed on 19 January 2006." Appellants' reply to the said Office action was filed on June 28, 2006, together with a proper Notice of Appeal. The respective reply contained no amendment and no affidavit or other evidence.

The Examiner, obviously erroneously, then issued an "Advisory action after filing of an Appeal Brief" (form PTOL-304) on August 02, 2006.

- 1) The form indicated in subsection (1.b) that: "The affidavit or other evidence is not timely filed before the filing of an appeal brief."

The assertion was clearly in error because appellants had not filed an appeal brief at that time, and because no affidavit or other evidence had been presented by appellants subsequent to the filing of the request for continued examination dated January 19, 2006.

- 2) The form also indicated in subsection (4): "Rejection over CURTZE et al. (...) is maintained because arguments are not found persuasive. The term 'comprising' allows for the addition of other

ingredients. DP rejection is also maintained. Claims 1, 2, 4 and 5 are pending and stand rejected."

Appellants' brief was filed subsequent to the Notice on August 28, 2006.

The Examiner's indication in subsection (3) of form PTOL-432 is therefore clearly in error.

The Examiner asserted in subsection (4) of form PTOL-462: "(a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41,37(c)(1)(v))."

The Examiner's indication in subsection (4) of form PTOL-432 is, in light of the foregoing and the summary of the claimed subject matter set forth in appellants' brief, clearly in error.

In additional reasons, summarized on a continuation sheet, the Examiner asserted "Copy of claims as submitted with brief does not contain the same subject matter as previous claims on record. No amendments were filed. (Hydrogen has been deleted from the definition of R in claim 1 which was not presented before)." Hydrogen had been deleted by appellants from the definition of R in appellants' paper dated June 10, 2005, in reply to a non-final Office action mailed on September 29, 2004. Appellants' respective reply had been presented in connection with a Petition under Rule 137(b) of even date with said paper, and the Petition had been granted per decision dated July 20, 2005.

In the additional reasons, the Examiner also asserted: "Status of claims are not disclosed." As noted in the foregoing, the status of the claims is specified in the appropriate section of appellants' brief.

The Examiner further asserted in the additional reasons: "The data presented in brief has been considered (not presented before)." As explained in appellants' Evidence Appendix:

1) *Dr. Stierl's Declaration dated January 16, 2006.*

The respective declaration was presented with appellants' Submission under 37 C.F.R. §1.114, filed on January 19, 2006, and entry of appellants' Submission was confirmed by the Examiner in the Office action dated February 28, 2006, as indicated in the Status section (1) of the PTOL-326 form and on page 2, lines 2 to 6, of said Office action.

2) *Dr. Stierl's Declaration dated June 06, 2005.*

The respective declaration was presented with appellants' Reply under 37 C.F.R. §1.111, filed together with a Petition under 37 C.F.R. §1.137(b), dated June 10, 2006. The respective Petition was granted per Decision mailed on July 20, 2006, and entry of appellants' Reply was confirmed by the Examiner in the Office action dated August 19, 2005, as indicated in the Status section (1) of the PTOL-326 form and on page 2, lines 2 and 3, of said Office action.

Additionally, the Examiner indicated on the continuation sheet: "Claims will be allowed if (1) H is deleted from the definition of R in claim 1 as presented in copy of claims in brief. (2) The data as presented in the brief filed as 1.132 declaration. (3) File a 'Terminal disclaimer to overcome DP rejection." As concerns (1) it is respectfully reiterated that the denotation "H" had already been deleted from the definition of R, the respective amendment is of record, and no further action on the part of appellants should be necessary. As concerns (2) it is respectfully noted that the data contained in appellants' brief were presented in Dr. Stierl's Declaration dated June 06, 2005, as explained on page 3 of the brief. As concerns (3) appellants' respectfully refer to the reasons presented in their brief on pages 7 to 14 which explain why the Examiner's double patenting rejection was deemed to be in error.

In light of the numerous errors in the Notification of Non-Compliant Appeal Brief, and the discrepancies between the Examiner's assertions and the current record, it is respectfully urged that the Notification was issued in error. It is therefore requested that the Notification be revoked. Favorable action is solicited.